IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Hiroshi TAKEMOTO et al.) Group Art Unit: 1626
)
Application No.: 10/048,008) Examiner: L. Stockton
)
Filed: January 25, 2002)
)
For: PHARMACEUTICAL)
    COMPOSITIONS EXHIBITING)
    THROMBOPOIETIN RECEPTOR)
    AGONISM)

Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In the Office Action dated March 31, 2003, the Office required restriction under

35 U.S.C. §§ 121, 372 between:

Group I (claims 34-55, 68, and 69 (in-part), allegedly drawn to methods of using products of formula (I) wherein X^1 is a thiazole ring, Y^1 is $NR^ACO\text{-}(CH_2)_{0\text{-}2}\text{-}$, Z^1 is a phenylene and A^1 is a thiazolidine ring);

Group II (claim 34-55, 68, and 69 (in-part), allegedly drawn to methods of using products of formula (I) wherein X^1 is a thiazole ring, Y^1 is $NR^GCO\text{-}(CH_2)_{0\text{-}2}\text{-}$, Z^1 is a phenylene and A^1 is a oxazolidine ring);

Group III (claims 56-67 and 70-76 (in-part), allegedly drawn to products wherein X^2 is a thiazole ring, Y^2 is $NR^GCO\text{-}(CH_2)_{0\text{-}2}\text{-}$, Z^2 is a phenylene and A^2 is a thiazolidine ring); and

Group IV (claims 56-67 and 70-76 (in part), allegedly drawn to products wherein X^2 is a thiazole ring, Y^2 is $NR^GCO\text{-}(CH_2)_{0\text{-}2}\text{-}$, Z^2 is a phenylene and A^2 is a oxazolidine ring).

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In response, Applicants hereby elect to prosecute group III, *i.e.*, claims 56-67 and 70-76 (in-part), wherein X^2 is a thiazole ring, Y^2 is $NR^GCO-(CH_2)_{0-2}-$, Z^2 is a phenylene and A^2 is a thiazolidine ring.

Although the above election has been made in order to advance prosecution, Applicants respectfully traverse the restriction requirement, and request that all the claims be examined together. Applicants traverse the Restriction for at least the reason that the PCT rules have been applied too narrowly.

For example, although it is stated in the Office Action that the claims lack unity under PCT Rules 13.1 and 13.2 because "the compound defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art" (Office Action at 4), the guidelines state that in the case of a Markush group unity of invention is met where "[a] common structure is present, i.e., a significant structure element is shared by all of the alternatives" (MPEP § 1850(D)). However, in the present case, restriction has been required within Markush groups notwithstanding their common structural elements.

For instance, as set forth in claim 56,

Y^2 is $-NR^GCO-(CH_2)_{0-2}-$, $-NR^GCO-(CH_2)_{0-2}-W-$, $-NR^GCO-CH=CH-$, $-W-(CH_2)_{1-5}-NR^GCO-(CH_2)_{0-2}-$, $-W-(CH_2)_{1-5}-CONR^G-(CH_2)_{0-2}-$, $-CONR^G-(CH_2)_{0-2}-$, $-(CH_2)_{0-5}-NR^G-SO_2-(CH_2)_{0-5}-$, $-(CH_2)_{0-5}-SO_2-NR^G-(CH_2)_{0-5}-$, $-NR^G-(CH_2)_{0-2}-$, $-NR^G-CO-NR^G-$, $-NR^G-CS-NR^G-$, $-N=C(-SR^G)-NR^G-$, $-NR^GCSNR^GCO-$, $-N=C(-SR^G)-NR^GCO-$, $-NR^G-(CH_2)_{1-2}-NR^G-CO-$, $-NR^GCONR^GNR^FCO-$, or $-N=C(-NR^GR^G)-NR^G-CO-$.

Thus, as set forth in claim 56, the Markush group elements for Y^2 share the common structural element of having at least one $-NR^G-$ group.

Similarly, as set forth in claim 56,

> Z^2 is an optionally substituted phenylene, an optionally substituted 2,5-pyridine-diyl, an optionally substituted 2,5-thiophene-diyl, or an optionally substituted 2,5-furan-diyl.

Thus, as set forth in claim 56, the Markush group elements for Z^2 share the common structural element of being an optionally substituted, 5-6 membered ring group having at least two double bounds within the ring.

Accordingly, reconsideration and withdrawal of the Restriction Requirement are respectfully requested.

Should the Examiner still deem some restriction to be proper, it is respectfully requested that the restriction be broadened to at least include a larger number of species for any or all of groups X^2, Y^2, Z^2, and A^2. As shown above, there are common structural elements within these groups. Further, as a matter of public policy, it would be a burden on the public to have a large number of separate patents (which may be separately owned) covering different sub-genera of Formula (I) and Formula (II).

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 30, 2003   By:_____

Mark J. Feldstein
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